

II. REMARKS

This application is a continuation of patent application Serial No. 191,807, which was issued as U.S. Patent No. 6, 224,565 on May 2, 2001, for "Protective Sheath and Method for Ultrasonic Probes." The claims therein -- including an ultrasonic probe and associated sleeve -- were deemed patentable over the prior art.¹

The Office Action states that "the instant claims have been intentionally drawn toward the sleeve alone rather than toward the sleeve in combination with the probe" (Office Action, p. 3, "Remarks") This is not completely correct. While applicant concedes that the body of the claims focuses on features of the sleeve, it also refers to its relationship with aspects of the probe, such as the "probe," "housing," "outer surface of the probe," and a "flange" that circumscribes the probe. All of the features are identified in the preamble of the claim. It is well established that the preamble of the claim is part of the claim to the extent that it is necessary to "breath life and meaning" into the body of the claim. (Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).)

The Office Action rejects Claims 13 and 14-17 under 35 U.S.C. § 102 as being anticipated by the Mackool reference (i.e., U.S. Patent No. 5,354,265). Claim 13 is rejected as

¹ Simultaneously with this response, applicant has submitted an information disclosure statement including a completed Form 1449 and the references cited therein. These references were made of record in connection with the parent application, and applicant desires to have the consideration of these references reflected in these proceedings and on any resulting patent.

obvious over Mackool further in view of Hood et al. (i.e., U.S. Patent No., 5,746,713), which is cited to show the use of a sleeve made of “either rigid plastic or metal.”

The rejections are not factually correct. Mackool does not anticipate the subject matter of Claims 12 and 14-17 and is not a proper primary reference for the obviousness of Claim 13. Mackool does not show a sleeve having all of the features of Claim 12. For example, the claim requires a sleeve that cooperates with the flange “thereby forming generally a barrier to the passage of material into the clearance” between the sleeve and the probe. In contrast Mackool shows a “ported” device that deliberately permits the flow of material between the space between the sleeve and the instrument and the tissue being operated on. (See, e.g., Abstract and Fig. 1, item 20.)

It is apparent from the “Remarks” on page 3 of the Office Action that it is the position of the Patent Office that:

... limitations about the sizing and fitment of the sleeve on the probe are functional recitations and therefore carry no patentable weight. Any sleeve could meet the size/fitment limitations as long as you put the right size probe inside it. But since the probe is not positively claimed, the spacing between the sleeve and probe in the prior art references is irrelevant.

Unfortunately, no legal authority is provided in the Office Action to support this proposition which applicant believes is contrary to Corning and other legal precedent regarding the interrelationship between the preamble and the body of the claim. That authority does not suggest that it is proper to ‘read out’ of the claim preamble elements that appear in the body of

the claim. Since no authority for the above quoted “remarks” has been set forth in the Office Action, applicant cannot respond further at this time.

It is apparent to the applicant and implicit in the Office Action that Mackool does not anticipate the subject matter of Claim 12 or any of the other claims if all of the terms in the claims are given effect. The issue turns on whether or not all of the terms in the body of the claims are to be given effect. No authority has been provided for the Patent Office’s position on this pivotal legal issue.

III. CONCLUSION

For the reasons set forth above, applicant respectfully submits the Office Action was an improper “final” action and that it be withdrawn. Applicant respectfully submits that the claims are in condition for allowance; prompt allowance is respectfully requested.

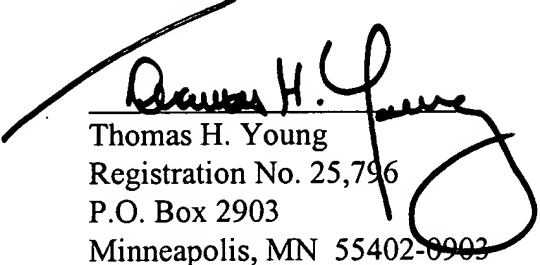
It is applicant’s belief that no fee (other than that associated with the accompanying request for extension of time and the request for continued examination) is required in association with this Response. However any deficiency should be credited, or overpayment debited, to Account No. 04-1415 — with reference to Docket No. 40206.0001USC1.

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Respectfully submitted this 16th day of September 2002.

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